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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,256	04/05/2001	Stephen A. Empedocles	019916-004100US	4344

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EXAMINER

SMITH, ZANDRA V

ART UNIT PAPER NUMBER

2877

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/827,256	Applicant(s) EMPEDOCLES ET AL.	
	Examiner Zandra V. Smith	Art Unit 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 11, 17, 18, 24, 25, 27, 32, 34, 35, 37-42, 45, 47, 48, 53 and 54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5, 11, 24, 25, 27, 32, 34, 35, 37-42, 45, 47, 48, 53 and 54 is/are allowed.
- 6) ☒ Claim(s) 17-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendment, dated 16 February 2005, has been entered and an office action in response follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by *Kambara et al.* (US 6,288,220 B1).

As to **claim 17**, Kambara discloses a DNA Probe array, comprising:
spatially restraining a plurality of spectrally labeled bodies (col. 15, lines 3-15);
directing a spectrally dispersed image of the array of bodies onto a sensor (col. 15, lines 3-15); and identifying the bodies, wherein the bodies are arrayed in a two-dimensional array supported by a table (col. 15, lines 5-10). Additionally, the container for the two-dimensional

Art Unit: 2877

array may be partitioned into compartments for holding the individual probes in the array (col. 16, lines 25-35, see fig. 10). Kambara differs in that the two-dimensional container is not disclosed as being a multi-well plate, however since it is a two-dimensional array supported by a table divided into compartments and since a multi-well plate is a two-dimensional array of compartments, the limitation is inherently met.

As to **claim 18**, Kambara discloses everything claimed, as applied above, in addition a fluid is used to draw and expel the array of bodies (col. 12, lines 25-40).

Allowable Subject Matter

Claims 5, 11, 17-18, 24-25, 27, 32, 34-35, 37-42, 45, 47-48, and 53-54 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, taken alone or in combination, fails to disclose or render obvious a spectral label identification system that includes spatially restraining first and second spectrally labeled bodies at a plurality of sites and identifying the second body for a second spectrum wherein a first plurality of spectrally labeled bodies are simultaneously spatially restrained at the array of sites when the first body is restrained and wherein a second array of spectrally labeled bodies are simultaneously spatially restrained at the array of sites when the second body is restrained, sequentially spatially restraining the bodies and drawing the first body into an opening by drawing fluid into the opening, expelling the body from the first opening and repeating with the second body, the openings are sized to receive a single body therein so as to separate the individual bodies for discrete imaging, the dispersed image having a dispersion axis at an angle to the a line onto the sensor surface, moving the restrained body within the fluid by moving the restraining energy or the fluid; sweeping the restraining energy through the fluid to move the

Art Unit: 2877

first body toward a first site, or sweeping the restraining energy through the fluid to move a second body toward a second site and inhibiting transmission of the restraining energy between the first and second sites, in combination with the rest of the limitations of the claims.

Response to Arguments

Applicant's arguments with respect to claims 17-18 have been considered but are moot in view of the new ground(s) of rejection.


Fax/Telephone Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zandra V. Smith whose telephone number is (571) 272-2429.

The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley Jr. can be reached on (571) 272-2800 ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Zandra V. Smith
Primary Examiner
Art Unit 2877